

REMARKS

Claims 1 - 9 are pending in the present application.

The Examiner has required election in the present application between:

Group I, claims 1-2, drawn to a method and/or system for controlling a waveform, classified in class 335, subclass 72;

Group II, claims 3-9, drawn to a method and/or controller for controlling the current of the magnet field in a wind of a charged particle beam system, classified in class 250, subclass 396ML; and

For the purpose of examination of the present application, Applicants elect, with traverse, Group II, claims 3-9.

Applicants respectfully traverse the Examiner's restriction requirement. As clearly stated in the Manual of Patent Examining Procedure, the Examiner "must provide reasons and/or examples to support his conclusion that the claims are distinct." The Examiner has not made any factual finding in any way related to the alleged distinctness of the respective Group I and Group II inventions. In fact, all statements in the Examiner's rejection are merely conclusory, the Examiner making the broad allegation that "differing limitations make the inventions of Group I and II patentably distinct from each other." It should be noted that the

Examiner's assertion that the claims are restrictable because a reference that anticipates or renders obvious one of the invention would not by itself anticipate or make obvious the other invention is statement also true when a dependent claim patentably defines over a patentable independent claim. Is the Examiner suggesting that a dependent claim may never be patentable over its associated independent claim?

The MPEP states that it is the Examiner's burden to present a *prima facie* case of restrictability. The Examiner has presented no factual case in support of restrictability, whatsoever. Consequently, since the Examiner has not met the burden of presenting a *prima facie* case of restriction, the Examiner's restriction requirement should not be maintained.

It should also be noted that the Examiner's allegation that a telephone call to request an oral election was made to John Castellano of this firm on February 24, 2003. However, Mr. Castellano has not been associated with this firm since September, 2001. This fact is routinely communicated to anyone asking for Mr. Castellano, and alternate attorney is offered.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Michael K. Mutter (Reg. No. 29,680) at the telephone number of the undersigned below, to conduct an interview

in an effort to expedite prosecution in connection with the present application.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicants respectfully petition for a one (1) month extension of time for filing a reply in connection with the present application, and the required fee of \$110.00 is attached hereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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By 

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